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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,238	08/02/2001	Benjamin Mosier	0468FV.044178	9707

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Constance Gall Rhebergen  
BRACEWELL & PATTERSON, L. L. P.  
P.O. Box 61389  
Houston, TX 77208-1389

EXAMINER

HAMLIN, DERRICK G

ART UNIT PAPER NUMBER

1751

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,238

Applicant(s)

MOSIER ET AL.

Examiner

Derrick G. Hamlin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 24 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,4,5,9,11-13,16,19-25,32-38,40,44 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4,5,9,11-13,16,19-25,32-38,40,44 and 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group 1, claims 2, 4, 5, 9, 11-13, 16, 19-25, 32-38, 40, 44 and 46-48 in Paper No. 4/24/04 is acknowledged. The traversal is on the ground(s) that the claims depend on the same independent claim. This is not found persuasive because the composition is not allowable and searches clearly diverge, requiring more than the search of Group 1.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Evaluations of level of ordinary skill in the art requires consideration of factors such as various prior art approaches employed, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, failure of others, and the inventor's educational level.

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The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this case reasonably reflect this level of skill.

Claims 2, 4, 16, 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein et al (US 5,468,405 A).

Klein et al disclose partially dehydrated castor oils having hydroxyl numbers in a range between 90 and 150 mg of KOH/g are useful as lubricants (abstract). The partly dehydrated castor oils used in accordance with the invention may be produced in known manner by dehydration of castor oils with hydroxyl values of 160 to 170 mg KOH/g in the presence of acidic catalysts, such as phosphoric acid, acid anhydrides, metal oxides showing an acidic reaction or hydrogen-containing salts showing an acidic reaction. For the purposes of the present invention, the partly dehydrated castor oils are preferably obtained from castor oils using phosphoric acid in accordance with GB 671,368, preferably in the presence of 0.1 to 1% by weight, and more preferably in the presence of about 0.25 to 0.75% by weight, based on castor oil, of phosphorous acid, and at temperatures in the range from 230- 260 degrees C. (col. 1, line 64 – col. 2, line 13)

The reference is anticipatory.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Evaluations of level of ordinary skill in the art requires consideration of factors such as various prior art approaches employed, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, failure of others, and the inventor's educational level.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this case reasonably reflect this level of skill.

Claims 5, 9, 11-13, 24, 25, 32-38, 40, 44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al (US 5,468,405 A).

Klein is relied on for the disclosure above. The reference also teaches many natural and synthetic ester may be used, such as castor oil esters (col. 1, lines 21-34) and partly dehydrated castor oils used in accordance with the invention may be used with known base oils, such as mineral oils, synthetic ester oils of dicarboxylic acids and alkanols or dicarboxylic and monocarboxylic acids and alkanols and with natural esters, such as triglycerides (col. 2, lines 36-45).

The reference fails to reach all of the instantly claimed compounds.

Although the reference fails to reach all of the specific instantly claimed compounds, it does generally teach that the compounds may be used. For example, the reference does not teach one of the many alcohols of claim 24, but it does teach alkanols may be used, which reads on many of the alcohols of claim 24. Additionally,

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all the alcohols and esters of the GB 671,368 reference are incorporated by reference into Klein. Therefore in the absence of showing superior or unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the instantly claimed composition as the reference teaches that a partly dehydrated castor oil, obtained from castor oils using phosphoric acid in accordance with GB 671,368.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (571) 272-1317. The examiner can normally be reached on Monday-Fridays from ~8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

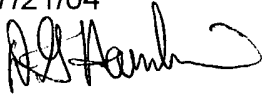
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick G. Hamlin

7/21/04



*Lorna M. Douyon*  
LORNA M. DOUYON  
PRIMARY EXAMINER